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P/1629-43  
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of #22

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of

John SKALEN

Serial No.: 09/787,750

Filed: May 21, 2001

For: GOLF TRAINING DEVICE

Appeal No.: 2004-0064

Date: March 8, 2004

Group Art Unit: 3711

Examiner: M. Chambers

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION AND/OR REMAND  
UNDER 37 C.F.R. §1.197(b) AND/OR 37 C.F.R. §1.196**

Appellant respectfully requests that, pursuant to 37 C.F.R. §1.197(b) and/or 37 C.F.R. §1.196, the Board of Patent Appeals and Interferences (the Board) reconsider and reverse the final rejection herein, or, in the alternative, that it amend its opinion to clarify the basis for its decision, and then to remand this matter to the Examiner for reconsideration under 37 C.F.R. §1.196(b), or remand under 37 C.F.R. §1.196(a) for determination if a rejection based on inherency is warranted.

The Petition fee of \$130.00 is attached hereto. If any additional fees are required, the same may be charged to our Deposit Account No. 15-0700.

**BACKGROUND**

The invention which is the subject of this proceeding is a practice device for the game of golf. As illustrated in the single drawing figure, the device is constructed of a non-resilient line (3) having a ground anchor (4) at one end and a golf ball (1) tethered at the other end, a resilient line (7) having ground anchors (8, 9) at its ends, and a connecting ring (6) through which lines (3) and (7) can pass freely. When set up, lines (3) and (7) are positioned at 90 degrees to each other, and the

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anchors (4, 8, 9) are driven into the ground with line (7) stretched taut. Colored markings (A, B, C) on non-resilient line (3) serve as reference marks to indicate the crossing points of the resilient and non-resilient lines for proper operation with different golf clubs. If the user wants to practice with an iron which is intended provide high loft, the reference marks indicate a crossing point for which the rest position of the ball is closer to the resilient line than for use with a driver which provides less loft, but greater travel distance.

When the ball is hit, the coupling of lines (3, 7) through ring (6) transfers energy to the resilient line, causing the latter to stretch as the ball flies out. When the forward motion of the ball is arrested by the non-resilient line, the energy stored in the resilient line causes the ball to return toward the starting position.

If the device is properly set up for the club being used, and the ball is properly hit, it will return along its outgoing flight path and roll to a stop near the starting position. If it is hit improperly, however, it will not return to the starting position. In particular, if the ball is "hooked" or "sliced", its resting place will be to the right of left of the outgoing path. If the ball is hit straight, but the point of contact by the club is too high or too low, the right amount of energy will not be transferred to the resilient line to return the ball to the starting position. If the amount of energy is too great, the ball will not roll to a stop, but will rebound out again from the starting position. If the amount of energy is too small, the ball will stop short of the starting position. Therefore, an immediate and reliable indication is given of the quality of the shot.

If the device is set up for use with a driver, for example, and an iron is used, the crossing point will be too far from the ball, and even a proper shot will not transfer sufficient energy to the resilient line to return the ball to the starting position. If, however, the device is set up for use with an iron, but a driver is used, the crossing point will be too close to the ball, and a proper shot will transfer too much energy to the elastic line. In that case, the ball will rebound.

The claims in the application were finally rejected as obvious over Deane British Patent 401,955 in view of Windall U.S. Patent 3,122,369. Both of these disclose golf practice devices including markings which cooperate with a pointer to indicate apparent ball travel distance. Deane's distance markings are on a tape (11) which is intended to be placed *under* a non-resilient line 5. Windall's distance markings (16, 17, 18, 19) are directly on line (8) rather than on a separate tape.

Neither reference teaches or suggests using markers of any kind to aid in setting up the device differently for use with different clubs. *Also, as demonstrated below, the markers in the references are not capable of functioning to indicate proper crossing points for use with different clubs.*

An appeal of the final rejection was taken, upon which, appellant relied on *In re Miller*, 57 CCPA 89, 418 F.2d 1932, 164 U.S.P.Q. 46, 49 (CCPA 1969) and *In re Gulack*, 703 F.2d 1381, 217 U.S.P.Q. 401 (CAFC 1983). Appellant further argued that because the distance travel markers in the references did not and could not function as set up guides as called for in the claims, the final rejection was improper.

The Examiner, on the other hand, took the position that the function ascribed to the markers was not relevant, and that the only issue was whether Windall would make it obvious to modify Deane's device to place the distance markers on Deane's non-resilient line, rather than under it. In fact, the Examiner expressly disavowed any "printed matter" rejection, i.e., a rejection based on the function of the indicia (see Examiner's Answer, page 6).

On December 23, 2003, the Board handed down a decision affirming the final rejection. In that decision, the Board adopted the position of the Examiner that it would have been obvious to have modified Deane to place the distance markers on the non-resilient line. The Board rejected appellant's argument that the Examiner had improperly ignored the claim limitations as to the function of the set up markers, and that neither of the references function or could function to permit set up for use with different clubs, stating:

appellant has not explained, and it is not apparent to us, why the bead 11<sup>a</sup> and markers on the inelastic cord 5 of Deane would not inherently be capable of performing such function . . .

Nothing in either . . . [the *Miller* or *Gulack* cases] indicates that the prior art must teach the recited function or purpose of the printed matter at issue in order to render the claimed subject matter unpatentable. Where the structure, in this case the graduated markers on Deane's cord 5, reasonably appears capable of functioning in the manner called for in the claims, the burden shifts to appellant to prove that the prior art does not possess the characteristic at issue.

## ISSUES ADDRESSED HEREIN

The following issued will be addressed:

(a) Did the Board rely on a new ground of rejection in its decision when it shifted the burden to appellant to explain, why the bead 11a and markers on the inelastic cord 5 of Deane would not inherently be capable of performing "the set up guidance function of appellant's markers?"

(b) Did the Board properly impose on appellant the burden of disproving inherency?

c) Assuming the Board properly imposed the burden of disproving inherency on appellant, are the devices disclosed in either of the references inherently capable of guiding a user in setting up the respective devices for use with different clubs?

(d) What action should be taken by the Board at this time?

#### **The Board Relied on a New Ground of Rejection in its Decision**

In the final rejection, the Examiner stated that:

... It would have been obvious to one of ordinary skill in the art ... to have employed the indicia of Windall with the apparatus of Deane in order to reduce the manufacturing cost and reduce the number of sub-components of the apparatus. Note that the phrases in the claim directed to the intended manner of use of the device cannot be used to distinguish over prior art disclosing the structure.

37 C.F.R. 1.196(a) provides that the Board:

may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner . . .

The "grounds specified by the examiner" to which the foregoing applies are solely those stated in the final rejection, *In re Webb*, 916 F.2d 1553, 16 U.S.P.Q.2d 1433 (CAFC 1990). Further, under 37 C.F.R. 1.113(b):

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

Accordingly, any issue not clearly addressed in the final rejection on which the Board bases its decision, is of necessity a ground not involved in the appeal, i.e., a new ground of rejection to which 37 C.F.R. 1.196(b) applies, *In re Webb*, 916 F.2d at 1557, 16 U.S.P.Q.2d at 1435.

The examiner did not clearly specify or even mention, inherency as ground for rejection in the final rejection. Therefore that issue was not before the Board. But the Board clearly relied on appellant's failure to explain why the bead 11a and markers on the inelastic cord 5 of Deane would not inherently be capable of performing the set up guidance function of appellant's markers. This must accordingly be treated as a new ground of rejection, even though the Board did not denominate it as such.

**The Board Did Not Follow its Own Precedent When it Imposed on Appellant the Burden of Disproving Inherency**

It is well established that where the PTO has reason to believe that a functional limitation asserted to be critical to establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on, *In re Swinehart*, 439 F.2d 210, 169 U.S.P.Q. 226 (CCPA 1971). The Board, in its opinion, clearly imposed the burden of *disproving* inherency on appellant. As explained above, the issue of inherency had never been raised by the Examiner.

The Board, of course, has the authority to raise the issue of inherency, but it is respectfully submitted that it did so in a manner is entirely contrary to its own precedent, as stated in *Ex parte Skinner*, 2 U.S.P.Q. 2d 1788 (BdPatsApp&Int 1986).

In *Skinner*, the Examiner stated in the final rejection, that although the applied reference "does not explicitly disclose the properties claimed by appellant, such properties *may be* inherent characteristics of the reference . . ."

The Board reversed, holding:

Inherency, however, may not be established by probabilities or possibilities. . . before an appellant can be put this burdensome task [of disproving inherency], the examiner must provide some evidence

or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art. *Ex parte Skinner, supra*, at 1789.

It is respectfully submitted that the Board provided no evidence or scientific reasoning in its opinion to establish the reasonableness of requiring appellant to demonstrate why the bead 11<sup>a</sup> and markers on the inelastic cord 5 of Deane would not inherently be capable of aiding the user in setting up the patented device for proper use with different clubs. Instead, it relied on precisely the same type of speculation which the Board had found to be inadequate in the *Skinner* case.

Under 37 C.F.R. § 1.196(b), where, as here, there is a new ground of rejection by the Board, appellant has the option to submit an appropriate showing of facts relating to the claims so rejected, and to have the matter remanded for reconsideration by the examiner, but to remand the matter on the basis of a decision which is contrary to the principles of *Ex parte Skinner, supra*, would be manifestly unfair.

**The Board Should Remand This Matter to the Examiner Pursuant to 37 C.F.R. 1.196(a) or 37 C.F.R. 1.196(b)**

As demonstrated above, the issue of inherency was not addressed in the final rejection, and the Board did not state a proper basis for imposing the burden of disproving inherency on appellant under *Ex parte Skinner, supra*. Under 37 C.F.R. 1.196, the Board is authorized to consider issues not addressed in the final rejection, or to remand to the examiner for development of a record in the first instance, *Ex parte Daniels*, 40 U.S.P.Q. 2d 1394, 1408 (BdPatApp&Int 1996). Given the requirements of *Skinner* for evidence or scientific reasoning, it is respectfully submitted that both sound examination practice and judicial economy dictate that this matter be remanded to the examiner for consideration of the question of inherency in the first instance.

Alternatively, if the Board decides to modify its opinion to provide the required evidence or scientific reasoning, appellant respectfully requests that the Board then remand this matter to the Examiner pursuant 37 C.F.R. 1.196(b).

Finally, if the Board is of the view that the a new ground of rejection has not been made, it is respectfully requested that this communication be treated as a request for reconsideration under

37 C.F.R. §1.197(b). In that event, the Board is respectfully requested to consider (a) the applicability of *Ex parte Skinner, supra* in reference to its imposition on appellant of the burden of disproving inherency, (b) the accompanying Declaration of Johan Andersson discussed below in reference to whether the inherency suggested by the Board in its opinion in fact exists.<sup>1</sup>

**The Devices Disclosed in Windall and Deane Are Not Inherently Capable of Guiding a User in Setting up the Respective Devices for Use with Different Clubs.**

In an effort to advance the prosecution of this application whether it is remanded for reconsideration by the examiner pursuant to 37 C.F.R. § 1.196(a) or (b) or reconsidered by the Board pursuant to 37 C.F.R. 1.197(b), there is submitted herewith a Declaration under 37 C.F.R. §1.132 by Johan Andersson demonstrating that the markings in the Windall and Deane devices can not provide set up guidance for proper use with different clubs. As stated in the Declaration, Andersson, a part-owner of the assignee of the instant invention, is an experienced golf professional with substantial training and practical experience in teaching and other aspects of the game, and also has technical training and experience related to various mechanical devices.

In the interest of brevity, a verbatim recitation of the contents of the Andersson Declaration will be omitted, but instead, paragraphs 13-18 of the Declaration, wherein Mr. Andersson explains why the reference devices are not inherently capable of guiding set of the reference devices for use with different clubs, is incorporated herein by reference, as if fully set forth herein. In addition, attention is respectfully directed to paragraphs 2-6 of the Declaration concerning Mr. Andersson's background, training and experience.

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1. Appellant is mindful of the provisions of 37 C.F.R. 1.195 concerning post-appeal declarations. However, if the Board treats this request purely as one for reconsideration pursuant to 37 C.F.R. §1.197(b), it is respectfully submitted that the requirements of 37 C.F.R. 1.195 for a showing of good and sufficient reasons are clearly met in this instance. *Ex parte Skinner, supra*, establishes at a minimum that the burden of disproving inherency should not be placed on an appellant without the question being explicitly raised. As the issue was never raised by the examiner, appellant has never had an opportunity or the need to refute a suggestion of inherency.

Further, if the matter is remanded to the examiner, appellant proposes to demonstrate the operation of the device according to this invention by way of a videotape, and accordingly submits herewith a Form PTOL 413A requesting a personal interview with the Examiner for that purpose.

## CONCLUSION

It has been demonstrated above that the Board's reliance on a purportedly inherent characteristic of the device of the Deane patent, and its imposition on appellant of the burden of *disproving* inherency, were contrary to its own precedent, and that this constituted a new ground of rejection. In view of the foregoing, appellant respectfully requests the Board to (1) withdraw its affirmance of the final rejection insofar as based on the inherent capability of Deane's distance markings to perform the set up function as claimed herein, and accordingly to reverse the final rejection, or (2) remand to the Examiner for consideration of the question of inherency in the first instance, or (3) to set forth an appropriate basis for its suggestion of inherency in accordance with the principles of *Ex parte Skinner, supra*, and to remand to the examiner for reconsideration on that basis, or (4) in the event the Board deems that it did not rely on a new ground of rejection, to treat this as a request for reconsideration under 37 C.F.R. §1/197(b), and to reverse the final rejection on the basis of the arguments herein, the material incorporated herein by reference from the Andersson Declaration, and the Andersson declaration as a whole.

Amendment.

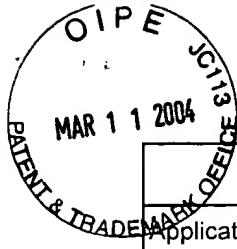
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 8, 2004:

\_\_\_\_\_  
Lawrence A Hoffman  
Name of applicant, assignee or  
Registered Representative  
Lawrence A Hoffman  
Signature  
\_\_\_\_\_  
March 8, 2004  
Date of Signature

Respectfully submitted,

Lawrence A Hoffman  
Lawrence A Hoffman  
Registration No.: 22,436  
OSTROLENK, FABER, GERB & SOFFEN, LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403  
Telephone: (212) 382-0700

LAH:sk



## APPLICANT INITIATED INTERVIEW REQUEST FORM

Application No.: 09/787,750 First Named Applicant: John SKALEN

Examiner: M. Chambers Art Unit: 3711 Status of Application: On appeal #2004-0064

## Tentative Participants:

(1) Examiner M. Chambers (2) Lawrence A Hoffman  
(3) (4)

Proposed Date of Interview: To be determined Proposed Time:  
(AM/PM)

## Type of Interview Requested:

(1) [ ] Telephonic (2) [ X ] Personal (3) [ ] Video Conference

Exhibit To Be Shown or Demonstrated: [ X ] YES [ ] NO

If yes, provide brief description: VIDEO TAPE

## Issues To Be Discussed

Issues (Rej., Obj., etc.)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) Rej.	All claims	Windall, Deane	[ ]	[ ]	[ ]
(2)			[ ]	[ ]	[ ]
(3)			[ ]	[ ]	[ ]
(4)			[ ]	[ ]	[ ]
(5)			[ ]	[ ]	[ ]

[ ] Continuation Sheet Attached

## Brief Description of Arguments to be Presented:

Neither reference can inherently provide set up guidance for use with different clubs.

An interview was conducted on the above-identified application on \_\_\_\_\_.

## NOTE:

This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP §713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR

Lawrence A Hoffman  
Registration No.:22,436  
Applicant/Applicant's Representative Signature

Examiner/SPE Signature

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual cases. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.